

Stein et al.

S/N: 10/604,459

REMARKS

Claims 24-43 are pending in the present application. In the Final Office Action mailed July 19, 2005, the Examiner provisionally rejected claims 24-43 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of co-pending Application No. 10/605,546. The Examiner next rejected claims 24-43 under 35 U.S.C. §102(b) as being anticipated by Prunier (FR 2,536,320). Claims 34-43 were further rejected under 35 U.S.C. §102(b) as being anticipated by Srba (USP 4,942,281).

The disclosure was objected to because of certain informalities. Applicant has made the appropriate corrections.

Finality of Action:

In the Office Action of March 24, 2005, the first action in the above captioned matter, the Examiner rejected each of the claims of the present application under 35 U.S.C. §102(b) as anticipated by French reference Prunier (FR 2,536,320). MPEP §706.02.II requires that “[i]f the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection.” (Emphasis added). The Office Action did not include a translation of the document relied on. Accordingly, not knowing what the reference states about the Figures, Applicant was unable to fully respond to the Examiner’s assertions. Without a translation of the document, rejections relying on anything more than the translated abstract thereof are clearly improper. Applicant must be given an opportunity to respond. The converse is equally true – if Applicant submits a foreign language reference for consideration, the Applicant has the burden of supplying a translation for full consideration. If the Examiner uses a foreign language document, the Examiner must supply a translation as well.

As stated in MPEP §706.07, “Before a final action is in order, a clear issue should be developed between the examiner and applicant.” MPEP §2271 further states that “[t]o bring the prosecution to a speedy conclusion and at the same time deal justly with the patent owner and the public, the examiner will twice provide the patent owner with such information and references as may be useful in defining the position of the Office as to unpatentability before the action is made final.” MPEP §706.07 further states that “present practice does not sanction hasty and ill-considered final rejections” and “[t]he applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application.” MPEP §706.02.II requires a translation of a foreign

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language document that is relied upon by the examiner in a non-final action to allow an applicant an opportunity to respond.

In the Final Office Action of July 19, 2005, responding to Applicant's arguments directed to the improper reliance on Prunier (FR 2,536,320), the Examiner states that "the 35 USC 102(b) rejections based on Prunier (FR 2,536,320) [presented in the Office Action of March 3, 2005] [were] not a result of reliance solely on the abstract" and that "the 'French text of specification and claims; and Figure' are also cited at the end of the paragraph." The Examiner openly admits that the rejections were based, at least in part, on the underlying, **non-translated**, portions of the reference. The Examiner further states that "a complete translation of a foreign document can take up to several weeks to obtain" and yet further requests "that applicants employ their resources to obtain a complete translation of pertinent foreign documents upon receipt of first and/or subsequent Office Actions to enable a complete reply and hasten prosecution history." Applicant is under no such duty. If the Examiner wishes to rely on a foreign reference, it is the Examiner's burden to provide proof that the document discloses what the Examiner asserts the document discloses.

The Examiner left a telephone message with the office of the undersigned on August 3, 2005 therein stating that "I do know a few French terms when I look at the specification, and I made [the rejection] final with the translation" and that in setting forth the rejections over Prunier (FR 2,536,320) "I didn't rely entirely on the Abstract." In the telephone message the Examiner further stated that "MPEP 700-21, the last two sentences; it doesn't say I can't make a final rejection" and that "it's kind of ambiguous ... but since I'm not relying entirely on the Abstract, I believe the final rejection is appropriate ... and it looks like a Petition would be the best route for you in this case." Additionally, even though MPEP §706.02.II requires that a translation **must** be provided, and even though an applicant has never had an opportunity to fully analyze the reference, the Examiner considers finality to be proper with initial presentation of the translated document.

The finality of the currently pending Office Action is clearly premature. Accordingly, Applicant has filed, concurrently herewith and under separate cover, a Petition to the Director under 35 C.F.R. §1.181 for review of the finality of the Office Action of July 19, 2005 and requesting therein that the finality of the Office Action be withdrawn as improper.

Provisional Obviousness-type Double Patenting Rejection:

The Examiner provisionally rejected claims 24-43 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of copending Pat. App.

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Ser. No. 10/605,546. As stated in MPEP §822.01, "[i]f the 'provisional' double patenting rejection is in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the 'provisional' double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent." Upon consideration of the amendments/remarks presented herein, the Examiner is required to withdraw the rejection in this matter and allow the above captioned Application to pass to issuance. That is, not until one of the above identified Applications issues as a patent will Applicant consider and/or address the appropriateness of filing a terminal disclaimer in the other co-pending matter.

Rejection under 35 U.S.C. §112, first paragraph:

The Examiner next rejected claims 24-33 under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement stating that "with regard to the amended independent claim 24, the new claim limitation 'dump for coolant' lacks support in the originally filed specification, and is thus considered to be new matter" and that "the applicants have not set forth the criticality of this new matter limitation in the originally filed specification." The Examiner has failed to provide, and Applicant is unaware, of any support for a requirement of an applicant to 'set forth the criticality' of any limitation.

Claim 24 calls for, in part, a cooling system having a coolant tank disposed within the enclosure and designed to be a source of coolant that is delivered to the welding torch and dump for coolant that has been circulated to the welding torch. As stated in the MPEP §2163.I, "[t]o satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention." MPEP §2163.I further states that "[w]hile there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure." Paragraph [0022] of the Specification states that:

During one operational embodiment, the pump 48 draws coolant from tank 46 and delivers the coolant to torch 32 through coolant path 49. The coolant absorbs heat from the torch and carries the heated coolant to heat exchanger via path 62. The heat exchanger 60 may include a coiled radiator to remove the heat from the coolant to the surrounding atmosphere and dissipated by fan 61. The cooled coolant is then re-deposited in tank 46 and further allowed to cool before re-circulated back to torch 32.

A coolant tank designed to be a source of coolant that is delivered to the welding torch and dump for coolant that has been circulated to the welding torch, as called for in claim 24, is clearly

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disclosed in the above-captioned application. That is, a person of ordinary skill in the art would readily recognize that the coolant tank, being a tank constructed to hold a coolant material, includes a quantity of reserve material accumulated at one place, or a dump. The common dictionary definition of a dump as used in the present claims -- a courtesy copy of which is attached hereto -- defines a dump as "a quantity of reserve materials accumulated at one place" or "a place where such materials are stored." Clearly, as stated in the cited portion of the Specification, a person of ordinary skill in the art would readily appreciate that the tank called for in claim 12 is designed to be a dump, or a place where reserve coolant is stored for recirculation to the torch. Accordingly, Applicant requests that the 35 U.S.C. §112, first paragraph be withdrawn as unsupportable.

Rejection of Claims Over Art of Record:

The Examiner rejected claims 24-43 as anticipated by Prunier (FR 2,536,320). As stated in MPEP §2131, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Applicant has amended claim 24 to incorporate the subject matter of claim 29 to further call for, in part, a controller configured to control the cooling system and the power conditioner. Claim 29 is hereby withdrawn. If the Examiner does not withdraw the finality, this amendment should still be entered because it was previously presented and considered in claim 29. Not only does Prunier (FR 2,536,320) fail to disclose any controller, Prunier (FR 2,536,320) fails to disclose a controller configured to control the cooling system and the power conditioner as called for in claim 24. Furthermore, Prunier (FR 2,536,320) discloses that the cooling system thereof is "applicable to other types of welding machines with torches, for example to plasma machines." Prunier, translation pg. 12, ¶1. Accordingly, that which is called for in claim 24 is not shown, disclosed, taught, or suggested in Prunier (FR 2,536,320). As such, Applicant believes claim 24, and those claims that depend therefrom, are patentably distinct over Prunier (FR 2,536,320).

The Examiner rejected claim 34 as anticipated by Prunier (FR 2,536,320) stating that "the French document includes the limitations of independent claims 24, 34, and 40 -- see translation of French text and newly underlined portion of paragraph 7." Although Applicant appreciates the Examiner's citation to the entirety of the translation of Prunier (FR 2,536,320), the newly underlined portion to which the Examiner directs Applicant's attention, merely states (enabling recycled supply -- both a source and dump for coolant). That is not what is called for in claim 34. Claim 34 calls for, in part, a cooling system configured to circulate coolant to regulate a temperature in the enclosure which is not disclosed by Prunier (FR 2,536,320). There is no

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disclosure in Prunier (FR 2,536,320) that the cooling system thereof is configured to circulate coolant to regulate a temperature in the enclosure of the welding-type power source.

The Examiner also rejected claim 34 as anticipated by Srba. In setting forth this rejection the Examiner has merely reproduced the elements of each of the independent claims and provided the citation "abstract; column 2, line 42 through column 4, line 61; column 5, line 35 through column 10, line 47; and Figures 1-6" for support of the rejection. Again, Applicant appreciates the Examiner's efforts in providing a concise citation to the reference for the support for the rejection. Nonetheless, Applicant respectfully disagrees that that which is called for in claim 34 is shown, disclosed, taught, or suggest in the art of record.

Claim 34 calls for, in part, a cooling system disposed in the enclosure and configured to circulate coolant to regulate a temperature in at least the enclosure. The art of record does not teach, suggest, or disclose such a cooling system. Both the cooling system of Prunier (FR 2,536,320) and the cooling system of Srba are configured to cool the torch. That is, there is no disclosure or suggestion in either reference that the cooling systems thereof are configured to regulate a temperature in the enclosure as called for in claim 34. A review of the citations provided by the Examiner clearly indicates the lacking of the references, individually or in combination, to show, disclose, teach, or suggest that which called for in claim 34. The references do not disclose or suggest circulating coolant to regulate a temperature in at least the enclosure as called for in claim 34. Accordingly, Applicant believes claim 34, and the claims that depend therefrom, are patentably distinct over the art of record.

The Examiner also rejected claim 40 as anticipated by Prunier (FR 2,536,320) and/or Srba stating that "both references are inclusive of valves that are able to be manipulated by hand and by automatic control." The Examiner further states that "[e]ven if 'automatic' control would not be specifically disclosed in the prior art references, the ability for an element to be 'automatic' is not a patentable feature by itself, as it has been held that providing a mechanical or automatic means to replace manual activity which accomplished the same result involves only routine skill in the art." Applicant respectfully disagrees.

Claim 40 calls for, in part, at least one check valve integrated with the cooling system and biased to a closed bias position to prevent coolant leakage from the power source when the welding torch is disconnected from the power source and configured to automatically overcome the closed bias position to allow coolant flow to a coolant-cooled welding torch that is connected to the power source **when the coolant-cooled welding torch is activated**. There is no disclosure in Prunier (FR 2,536,320) or Srba that the cooling systems respectively disclosed therein are any

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different than the cooling system discussed in the Background in the present Application. The Examiner has provided no credible support for the assertion that "both references are inclusive of valves that are able to be manipulated ... by automatic control." The references disclose cooling systems that must be configured and started manually prior to initiation of a welding-type process. As discussed in paragraphs [0003] and [0004] of the Background, manual manipulation of the cooling system controls subjects the welding apparatus so equipped to the inadequacies of human operators. Operators who may fail to turn the cooling system on, may also fail to turn the cooling system off, and may also prematurely turn off the cooling system upon termination of welding operations. Any of these events present the potential for premature wear of the weld components, torch damage, and inefficient torch operation. Nonetheless, a welding system as called for in claim 40 is not shown, disclosed, taught, or suggested in the art of record.

The Examiner's assertion that "it has been held that providing a mechanical or automatic means to replace manual activity which accomplished the same result involves only routine skill in the art" is not wholly accurate. As stated in MPEP §2144.04.III., as quoted from In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) "...broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art." (Emphasis added). Claim 40 calls for, in part, at least one check valve integrated with the cooling system and biased to a closed bias position to prevent coolant leakage from the power source when the welding torch is disconnected from the power source and configured to automatically overcome the closed bias position to allow coolant flow to a coolant-cooled welding torch that is connected to the power source when the coolant-cooled welding torch is activated. This cannot be said to provide "the same result" as the manual system. Applicant has not broadly provided an automatic means to simply replace a manual activity. Each of the systems of Prunier (FR 2,536,320) or Srba require an operator, prior to a welding operation, to configure the cooling system to circulate a coolant through the torch.

As the learned Examiner is probably well aware, once an operator desires to initiate a welding process, the operator puts on several protective elements to protect the operator from the intense heat and light associated with the welding process. These elements generally include heavy gloves, a welding jacket, and a welding helmet. The welding helmet protects the operators eyes from the high intensity energy generated during a welding process. The welding helmet also effectively prevents the operator from performing manual tasks remote from the welding process due to the tinted nature of the viewing shade of the helmet. Furthermore, the weld area can be more than an arms reach from the welding apparatus to protect the welding apparatus from the

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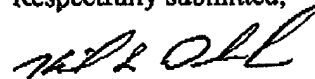
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heat and spatter associated with the welding process. As such, the operator of either of the systems Prunier (FR 2,536,320) or Srba would likely be incapable of manually initiating the cooling system when the coolant-cooled torch is activated as called for in claim 40. That is, the manual activities are incapable of producing the same result – i.e. allowing coolant flow to a coolant-cooled welding torch that is connected to the power source when the coolant-cooled welding torch is activated – as called for in claim 40. Accordingly, not only does the art of record not disclose that which is called for in claim 40, the Examiner's analysis in setting forth the rejection is unsupported by the art of record. For all the reasons set forth above, Applicant believes claim 40, and the claims that depend therefrom, are patentably distinct over the art of record.

Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 24-43.

Applicant appreciates the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,



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Attorney Docket No.: ITW7510.054

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Merriam-Webster Online Dictionary

Thesaurus

3 entries found for **dump**.
To select an entry, click on it.

dump[1,verb]
dump[2,noun]
dump truck



Main Entry: ²**dump**

Function: *noun*

1 a : an accumulation of refuse and discarded materials **b** : a place where such materials are dumped

~~a quantity of refuse materials accumulated at one place or a place where such materials are stored~~

<ammunition *dump*>

3 : a disorderly, slovenly, or objectionable place

4 : an instance of dumping data stored in a computer

5 *often vulgar* : an act of defecation -- usually used with *take*

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Patent
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Stein et al.
 Serial No. : 10/604,459
 Filed : July 23, 2003
 For : Method and Apparatus to Adaptively Cool
 A Welding-Type System
 Group Art No. : 1725
 Examiner : Kern, K.

CERTIFICATION UNDER 37 CFR 1.400 AND 1.419

I hereby certify that, on the date shown below, this correspondence is being:

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Signature

Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

AMENDMENT/RESPONSE TO OFFICE ACTION
MAILED JULY 19, 2005

Dear Sir:

Responsive to the Office Action mailed July 19, 2005, please amend the Application as follows: